



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences**

In re Patent Application of

BRACEWELL

Atty. Ref.: SCS -540-522

Serial No. 10/507,002

TC/A.U.: 2123

Filed: September 8, 2004

Examiner: R. Guill

For: A METHOD, TOOL AND SYSTEM FOR INCREASING THE
EFFICIENCY OF A DESIGN PROCESS

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March 29, 2010

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Commissioner for Patents
P.O. Box 1450
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Sir:

REPLY BRIEF

This Reply Brief is responsive to the Examiner's Answer mailed January 28, 2010, the date of response to which is March 29, 2010 (March 28, 2010 falling on a Sunday).

Appellant's previously filed Appeal Brief considered by the Examiner is believed to respond to all issues of rejection cited in the Final Rejection mailed February 27, 2009 as the Examiner's Answer appears to be a virtual copy of the rejection in the Final Rejection and therefore the previously filed Appeal Brief is a complete and sufficient response. To the extent the Examiner's Answer between pages 15 and 25 is a response to the arguments noted in the Appeal Brief, Appellant will respond to the Examiner's comments in the order provided and under the headings noted in the Argument portion of the Appeal Brief.

Bridging pages 14 & 15 of the Examiner's Answer, the Examiner states that the initial portion of the "argument" between pages 6 and 8 of Appellant's Brief "appears to be an introduction with no argument." Actually the referenced portion contains the citations from the Court of Appeals for the Federal Circuit and the U.S. Supreme Court which provide the legal guidance as to the Examiner's burden in proving out a *prima facie* case of obviousness.

The Examiner does not dispute that these citations accurately reflect the state of the law of "obviousness" and the various burdens on the Examiner to establish a *prima facie* case of obviousness or the fact that adverse teachings in cited prior art can rebut any *prima facie* case of obviousness.

A. The Examiner's contention that one of Conklin, Hirose and Regli teaches the claim limitation "said directed link is bi-directional to permit a user to traverse the link in either direction" is still incorrect

In the Examiner's discussion beginning on page 15 of the Examiner's Answer, the Examiner again confirms that the Conklin, Hirose and Regli references do not teach the claimed "directed link between selected nodes" which is "bi-directional to permit a user to traverse the link in either direction." The Examiner again relies upon the Kogan, Nguyen and Weinreich references as support for his "Official Notice" that the claimed "directed link" is known.

The Examiner suggests that Appellant "admits that the Kogan reference discloses bi-directional links." However, Appellant does not admit that Kogan teaches the claimed "directed link." If the Examiner reviews Appellant's Brief carefully, and in particular the

paragraph bridging pages 9 and 10, it will be seen that while Appellant admits that Kogan teaches hyperlinks as being “bi-directional,” Appellant’s claim specifies “a directed link between selected nodes.”

In the preceding paragraph, the Appeal Brief notes that “if the Kogan patent is reviewed, while it discloses bi-directional links that have multiple endpoints, it is unclear as to how such a system could be incorporated into the framework of a ‘design knowledge information capture tool’” Appellant’s claim does not specify hyperlinks which are only “bi-directional” but rather, claims “a directed link between selected nodes” where that directed link is “bi-directional to permit a user to traverse the link in either direction.” Essentially, the Examiner ignores the claim language of “a directed link between selected nodes” and Kogan teaches multiple endpoints which is the direct opposite of “selected nodes.” The Examiner’s Answer dwells upon the admission that Kogan teaches a “bi-directional hyperlink” and ignores the fact that Kogan teaches multiple endpoints and therefore teaches away from the claimed “directed link between selected nodes.”

With reference to the Nguyen reference, the Final Rejection pointed out that the Examiner’s citation to column 4, lines 35-40 of Nguyen does not contain any teaching of bi-directionality for hyperlinks. This statement is completely correct, as between lines 35 and 40 there is no such disclosure. However, in the Examiner’s Answer, the Examiner changes his citation and now suggests that Nguyen teaches bi-directional hyperlinks at column 4, lines 10-40. A review of this additionally cited portion of the Nguyen reference indicates that it states “[h]yperlinks are bi-directional links from a source

anchor to a destination anchor.” So to this limited extent, the Examiner’s Answer is correct.

However, Appellant would point out that its independent claims are related to a “directed link between selected nodes” and then the directed link is defined as “bi-directional to permit a user to traverse the link in either direction.” There is no disclosure in Nguyen as to a “directed link.”

Appellant also notes that “nodes” are defined as “representing an item of said design knowledge” in claim 1 and therefore the claimed “directed link” is between selected items “of said design knowledge.” The Nguyen definition merely states that hyperlinks in general are bi-directional links from a source anchor to a destination anchor, but contains no teaching directed to Appellant’s claimed “directed link between selected nodes.”

The Examiner’s expansion of his reliance upon Nguyen to include lines 10-34, not previously cited in the Final Rejection, is very much appreciated but it still doesn’t meet his burden of demonstrating that the prior art discloses every feature of the claimed invention.

The Examiner’s comments with respect to the Weinreich reference (beginning in the second full paragraph on page 16) do not dispute Appellant’s Appeal Brief. The Appeal Brief essentially suggests that the discussion in Weinreich of bi-directional linking would lead one of ordinary skill in the art away from the claimed application in terms of a “directed link between selected nodes” wherein the “directed link is bi-directional.” Specifically, Weinreich, in the first column under “Bi-directional Links,”

teaches that “the retrieval of links that refer to the current document poses a serious problem.” The paragraph goes on to discuss a prototype web browser tool and an alternative proposal. The complete quote (which the Examiner parses in the Answer) states that “[b]oth approaches have their limitations if the number of links is high.” As the Examiner admits, “Weinreich proceeds to discuss methods to overcome the limitations.”

As a consequence of the above language in Weinreich, those of ordinary skill in the art, upon reading of the “serious problem” and the “limitations” admittedly discussed in Weinreich, would tend not to utilize these bi-directional links unless they were prepared to also include and implement the “workaround” fixes disclosed in Weinreich. The Examiner provides no evidence that those of ordinary skill would adopt the Weinreich “approaches” without the Weinreich “fixes,” and then combine the “approaches” with the teachings of the cited prior art references.

In any event, Appellant’s Appeal Brief is clearly correct when it says that Weinreich would lead one of ordinary skill in the art away from Appellant’s claimed “directed link between selected nodes” where the link is “bi-directional to permit a user to traverse the link in either direction” since the retrieval of links in both directions “poses a serious problem” as stated in Weinreich.

In the last paragraph regarding Appeal Brief heading A, the Examiner suggests that Appellant’s arguments are “merely unsubstantiated allegations without supporting argument or rationale.” While the Examiner’s opinion is appreciated, each of the Kogan, Nguyen and Weinreich references are discussed and it is pointed out that they failed to

disclose Appellant's claimed "directed link between selected nodes" where the "directed link is bi-directional" and each of the selected nodes are "an item of said design knowledge." The Court of Appeals for the Federal Circuit has held that "the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Appellants merely point out that the Examiner fails to meet his burden of identifying evidence which supports his allegation of obviousness.

The Examiner's general comments notwithstanding, he ignores the specific limitations recited in each of Appellant's independent claims and therefore the Examiner's Official Notice of the Kogan, Nguyen and Weinreich references does not fill the gap left by the Examiner's reliance upon the Conklin, Hirose and Regli references.

Even if all six references were combined, i.e., Conklin/Hirose/Regli/Kogan/Nguyen/Weinreich, there is still no disclosure of Appellant's claimed "directed link between selected nodes" with the additional limitations recited in the claims relating to the "nodes" and the "bidirectionality" of such "directed link."

Accordingly, the Examiner still fails to establish a *prima facie* case of obviousness in the Examiner's Answer.

B. The Examiner fails to provide any rationale for combining bits and pieces of the three cited references and then combining them in the manner of Appellant's independent claims

The Examiner's response to the heading B argument that the Examiner has failed to comply with the Supreme Court requirement noted in *KSR* extends from the beginning

of page 17 through the first partial paragraph on page 19. The Examiner reiterates his “hindsight reasoning” suggesting that the benefits in each of the cited patents would motivate one to combine those cited patents. If the Examiner’s view were correct, then every U.S. patent, which by definition must have some benefit (by statute it is “new and useful”), would be combinable with every other patent ever issued by the U.S. PTO. If this were the case, the U.S. Supreme Court would not have confirmed that “this analysis should be made explicit.” (This is discussed in the last paragraph on page 7 of Appellant’s Appeal Brief which the Examiner apparently dismissed as “an introduction with no arguments.” (Examiner’s Answer, page 15, line 1)). If the Supreme Court did not intend for an examiner to provide an explicit “analysis,” no mention would be made of any requirement to provide any rationale for combining references, nor would there be any requirement for a reviewing court or board to review the examiner’s analysis.

Furthermore, the Examiner does not explain how or why one of ordinary skill in the art would be motivated to depart from all of the other teachings of the patent which teaches a way to achieve the benefits recited in that patent and instead seek other patents to combine with that patent. In the Examiner’s Answer, the Examiner correctly notes that that the benefits of the Hirose teaching are taught in Hirose and that a combination of the Regli and Conklin references would provide the benefits recited in Regli. It is submitted that as a matter of law, merely referencing the generic benefits recited in a patent as a reason for combining only a portion of that patent with a portion of another patent is insufficient to meet the requirements of the Supreme Court as announced in *KSR*.

Furthermore, the Examiner does not provide any indication as to how or why one of ordinary skill in the art would choose a “directed link between selected nodes” which is the language of Appellant’s claims. He does not indicate that this is even disclosed anywhere in the Hirose, Conklin and Regli references, and as noted above, it is not disclosed in the Kovan, Nguyen and Weinreich references. If the claimed “directed link” is not disclosed in the six references, how can the Examiner logically contend that there is some disclosure of a benefit of using such a “directed link” in order to combine it with other features from the six references?

Interestingly, the Examiner does not address this question which is posed in the last paragraph on page 12 of the Appeal Brief, i.e., why combine elements in a manner which is taught only by Appellant’s independent claims to provide a benefit where that particular benefit is only taught in the present invention. The Examiner’s reliance upon the statutorily required benefit of all patents as motivation for combining that patent with another patent, regardless of whether the benefit is attributed to the claimed structures is simply an error of law and a misapplication of the requirements set out by the Supreme Court in *KSR* and as further fleshed out by the Court of Appeals for the Federal Circuit in its decisions stemming from the *KSR* case.

It is noted that the only legal support for the Examiner’s position in contravention of the *KSR* decision is a Court of Customs and Patent Appeals decision which is almost 40 years old (*In re McLaughlin*, 170 USPQ 209 (CCPA 1971)). The CCPA decision from 40 years ago does not trounce the Supreme Court’s requirement of 2 years ago, and it is reversible error for the Examiner to rely upon the CCPA decision.

Moreover, even if one takes the CCPA decision as a restatement of the law, its rationale of hindsight reasoning, i.e., only knowledge which was within the level of ordinary skill in the art at the time the invention was made, the Examiner does not demonstrate how or where there is any teaching of the claimed “directed link” recited in Appellant’s “presentation means.” The Examiner’s reliance upon six prior art references notwithstanding, the burden remains on the Examiner to both (a) show that each claimed feature is disclosed somewhere in the combination of references, and (b) that he provides some rationale as to his reasons for combining portions of references in the manner of Appellant’s independent claims.

The Examiner has simply failed to meet both burdens in establishing a *prima facie* case of obviousness in the Final Rejection and does not add anything in the Examiner’s Answer which would overcome this error.

C. The Examiner does not cite any portion of the Kogan, Nguyen and Weinreich references, which he alleges contains “bi-directional hyperlinks,” as teaching the claimed “directed link” as defined in the claims

The Examiner apparently relies only upon his Final Rejection rationale in responding to the Appeal Brief’s question as to where in any of the cited prior art references he alleges that the disclosed “bi-directional hyperlinks” are the claimed “directed link.” In response, the Examiner merely replies that “Examiner’s hyperlink is a bi-directional ‘directed link’, as recited in the rejection.” The question is not what is recited in the rejection, but where is the “directed link between selected nodes” as required and defined in Appellant’s independent claims in the cited prior art.

As noted in the Appeal Brief, if the Examiner cannot point to where or how a prior art reference teaches the claimed “directed link between selected nodes” or the feature that such directed link is “bi-directional to permit a user to traverse the link in either direction” and where the selected nodes “represent items of design knowledge stored in different files,” then there is simply no evidentiary disclosure of that claimed element.

The Examiner now generally alleges that Official Notice (presumably the Kogan, Nguyen and Weinreich references) teaches “a directed link between selected nodes which is bi-directional to permit a user to traverse the link in either direction” (Examiner’s Answer, paragraph bridging pages 19 and 20). However, as noted above, the “directed link” with the terms as defined in the claims is not present in any of the Kogan, Nguyen and Weinreich references, and rather, they are directed to bi-directional hyperlinks but have nothing to do with the claimed “directed link between selected nodes” which have a bi-directionality aspect.

Merely saying that it is so does not support the Examiner’s position. The burden is on the Examiner to establish where the claim terms are disclosed in the cited prior art references. Nowhere in the six-reference combination does the Examiner suggest that the details of the claimed “directed link between selected nodes” and its claimed “bi-directionality” is disclosed.

The Examiner does appear to suggest that “selected nodes represent items of design knowledge stored in different files is taught in the rejection by Conklin and Regli.” He doesn’t indicate where this taught in Conklin and Regli. Furthermore, he doesn’t indicate that Conklin or Regli or any other reference has a “directed link between

selected nodes” having these items of design knowledge or that the “directed link is bi-directional.”

It appears that the Examiner’s argument is, to use an electrical analogy, a statement that the invention of the transistor was obvious because a transistor merely puts two semiconductor diodes together and each diode works in its known fashion (an NP diode and a PN diode are physically interconnected to form an NPN transistor and the diode portions of the transistor each operate in exactly the same fashion that they would operate if separated). Using the Examiner’s rationale, the transistor would clearly be obvious to one of ordinary skill in the art. Appellant notes that this is simply not the standard of obviousness, nor can the Examiner meet his burden of showing where claimed elements are and some motivation for combining those elements by merely saying that there is a benefit to an NP diode and a benefit to a PN diode and therefore the combining of these two diodes would be obvious due to the known benefits.

The Examiner in his arguments clearly avoids the requirement of the Court of Appeals for the Federal Circuit and the Supreme Court in terms of establishing a teaching of Appellant’s claimed elements or rationale for combination thereof.

D. The Examiner fails to evidence any support for a *prima facie* case of obviousness

In the portion of Appellant’s Appeal Brief between pages 13 and 14, Appellant goes over the two-prong test set out by the Court of Appeals for the Federal Circuit and the Supreme Court *KSR* case requiring the Examiner to meet two burdens in order to establish a *prima facie* case of obviousness. First, he must demonstrate how and where

all claimed elements are disclosed somewhere in the combination of references and then even if this test is met, he then must provide some explicit analysis as to why elements should be taken from the references and combined in a manner disclosed only in Appellant's claims. Even if the Examiner meets those requirements, he only shifts the burden of proof to the Appellant. Without meeting those requirements, Appellant has no obligation to disprove the Examiner's faulty reasoning. Appellant also notes that a *prima facie* case of obviousness is completely rebutted if Appellant can establish that one of more of the combination references would lead one of ordinary skill in the art away from the combination.

The Examiner's only comment with respect to this portion of the Appeal Brief is that it appears to be "an introduction with no arguments." Importantly, the Examiner does not dispute that this portion of the Appeal Brief correctly states the Supreme Court's mandate regarding the correct review of obviousness rejections. Therefore the Examiner is deemed to acquiesce in the points made and the statement of the current state of the law regarding a *prima facie* case of obviousness and an adverse teaching rebuttal of that *prima facie* case.

1. The Examiner fails to meet his evidentiary burden of establishing that the prior art teaches all claimed elements

The Examiner apparently concurs that the Conklin reference fails to teach the claimed bi-directional "directed link," as he does not dispute the first paragraph under the above heading in Appellant's Brief. The Examiner apparently relies solely upon the Kogan, Nguyen and Weinreich references as disclosing bi-directional "directed links"

and the defects in the Examiner's arguments are noted in detail above in section A. Apart from that general allegation, the Examiner does not dispute the fact that if the Kogan, Nguyen and Weinreich references do not support the claimed "directed link between selected nodes," then his rejection of the independent claims and all claims dependent thereon under §103 is unsupported.

It is submitted that the Board need review only the detailed disclosure in the Kogan, Nguyen and Weinreich references to confirm that the claimed "directed link between selected nodes" is not disclosed in any of those references in order to reverse the Examiner's obviousness finding.

2. The Examiner fails to identify any evidence or provide any explicit "analysis" as to why one of ordinary skill in the art would pick and choose elements or method steps from the prior art references and then combine them in the manner of Appellant's claims

The Examiner does not dispute the Appeal Brief discussion as to the legal underpinnings of the requirements that the burden remains with the Examiner to provide the required "analysis." Instead of providing any support for his conclusion, the Examiner merely restates benefits which, by statute, must be recited in each of the cited prior art patents and then concludes that those benefits would motivate one of ordinary skill in the art to combine only portions of those patents in the manner of Appellant's claims.

The Examiner does not provide any further discussion as to how or why the benefits in Hirose of a purported "cost effective, useful and inexpensive design process recorder that benefits design and redesign" suggest any benefit in providing a "directed

link between selected nodes” where the directed link is bi-directional to permit a user to traverse the link in either direction and wherein said selected nodes represent items of design knowledge stored in different files. The same is true of each of the references mentioned by the Examiner, but he glosses over the requirement that the benefit of a particular element taken from one of the cited references must have something to do with the benefit of the claimed invention. The Examiner provides no indication of how or why any of the six cited references teach a benefit associated with Appellant’s claimed “directed link between selected nodes.”

The Examiner does not appear to dispute Appellant’s transistor analysis and therefore the burden remains on the Examiner to provide some “analysis” as to how and why he is taking portions of references (which portions may or may not be responsible for the benefit of that patent) and combining them in the manner of Appellant’s claims.

3. The Examiner apparently fails to appreciate that Weinreich specifically teaches away from the cited prior art combination

Appellant has already noted in section C above that the Weinreich reference teaches away from Appellant’s claimed combination. The Examiner does not dispute that, in each instance, Weinreich teaches a problem with the “approaches” that the Examiner relies on for the teaching of “a directed link between selected nodes.” Even if Weinreich goes further and provides methods to overcome those limitations, the Examiner assumes that Weinreich contains a teaching of the “directed link” without the required “methods to overcome the limitations.” Yet, this is exactly what the Examiner does – he seizes upon one or two words taken out of context in the Weinreich teaching,

but does not include the needed “methods to overcome the limitations” (needed to make the “approaches” reasonable) and then combines those words with other words taken out of context in the other five references.

The fact that Weinreich requires those additional solutions to the problems means that the Examiner cannot take merely the mention of the word apart from the solutions. They are part and parcel and there is no reason, at least as explained by the Examiner, why one of ordinary skill in the art would take the Weinreich “approach” which has limitations and “poses a serious problem” and use that approach without the concurrent Weinreich teachings of the additional needed “methods to overcome the limitations.”

The Examiner’s defective logic can perhaps best be exemplified by considering in detail the paragraph bridging pages 23 and 24 of the Examiner’s Answer. The Examiner purports to respond to the first full paragraph on page 19 of the Appeal Brief in which Appellant pointed out that Weinreich discloses that graphical maps use a lot of screen space if dozens of nodes and links are displayed. Appellant suggests that this teaches away from Appellant’s claimed “presentation means” and the next paragraph in the Appeal Brief goes on to note that the presentation means includes the claimed “directed link” and that there is no organization of these features in the Weinreich reference and in fact Weinreich teaches away from those references for the reasons previously discussed.

Instead of responding to these adverse teachings of the use of the Weinreich “approaches,” the Examiner merely states “there is no limitation in the Appellant’s claim that recites dozens of nodes and links.” Appellant’s Appeal Brief made no representation that there are “dozens of nodes and links” in Appellant’s specification and instead noted

that these were features in the Weinreich reference which would tend to teach away from Appellant's claimed "directed link between selected nodes." Thus, the Examiner apparently resorts to misunderstandings of what Appellant's have stated in the Brief and what the claims require and what is taught in the Weinreich reference in order to buttress his purported arguments.

The Examiner finally alleges that "Conklin teaches 'a directed link between selected nodes' at least on page 306, figure 2, left-side panel of the window, which displays directed links between selected nodes." However, subsection 3 of the Appeal Brief was with respect to the Weinreich reference and not the Conklin reference. It would appear that the Examiner is now admitting that the defect in Weinreich, i.e., in teaching away from the claimed combination, is somehow repaired by the Conklin reference.

However, in the Final Rejection (as noted on page 8 of the Appeal Brief), the Examiner admitted that Conklin did not teach the claimed "directed link is bi-directional to permit a user to traverse the link in either direction." This failure in the Conklin reference having previously been admitted by the Examiner cannot now be revived. In fact, it is the admitted failure of the Conklin, Hirose and Regli references with respect to teaching Appellant's claimed "directed link" and its "selected node," "bi-directional to permit a user to traverse the link in either direction" and "wherein said selected nodes represent items of design knowledge stored in different files" attributes are purportedly obvious in view of the "Official Notice" references, i.e., Kogan, Nguyen and Weinreich.

The Examiner's attempt to draw attention away from the adverse teaching in the Weinreich reference by bringing back the Conklin reference in spite of the Examiner's admission is not believed appropriate. Having failed to rebut the adverse teachings in Weinreich, those teachings clearly overcome any *prima facie* case of obviousness, even if one had been made in view of the six references as combined.

E. Examiner's response to the "Conclusion"

On page 25 of the Examiner's Answer, the Examiner suggests that the phrase "appears to teach" is somehow a "polite form" of "teaches." While the Examiner may consider this to be a "polite" form, it also indicates uncertainty on the Examiner's part as to whether or not the allegation is true.

Appellant was pointing out that "appears to teach" is not the legal standard of obviousness and the burden on the Examiner is not to identify evidence that "appears to teach" the features of the claim. Instead, the legal burden is on the Examiner to identify evidence that actually "teaches" the claimed elements and, as noted here, the Examiner fails to meet that burden for all the reasons noted.

However, since the Examiner requests that "appears to teach" should now be read as "teaches," a decision on the merits in this case is appropriate, as Appellant is confident that the Examiner has failed to meet his burden of proving that all claimed elements and all claimed interrelationships among elements are shown in the cited prior art references.

As a result of the above detailed discussion, there is simply no support for the rejections of Appellant's independent claims or claims dependent thereon under 35 USC

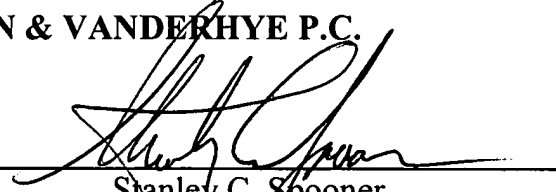
BRACEWELL
Serial No. 10/507,002

§103. Thus, and in view of the above, the rejection of claims 1, 2, 4-6, 8, 10, 15, 17-19, 22, 33, 41, 47, 48 and 50 under 35 USC §103 is clearly in error and reversal thereof by this Honorable Board is respectfully requested.

Respectfully submitted,

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